

REMARKS

Claims 1-23 and 38-59 are pending in the application with entry of this amendment. Claims 1, 14, 38 and 47 are amended. New claims 53-59 are added. The amendments and new claims do not present new matter. For example, the specification explains that base members 548a and 548b may be “formed from polyurethane” which, as is well understood by persons of ordinary skill in the art, is a type of polymer and a non-metallic material. As shown in Fig. 21, a groove is formed therein, or within an interior of the base member. The specification also explains that the mating structure of a base member is configured to removably mate with a slot in a clamp. This is done by the wider section 558 being slidably inserted into slot 520 through groove 552 as shown in Figs. 21 and 24. Further, as shown in Fig. 21, the coagulation element is carried on the support member, which is positioned within the coagulation element. The specification also explains that “adhesive may be used to hold the electrode 526a and support structure 530a in place. The application also explains, and as also illustrated, that “about 20% of the electrode surface (i.e. about 75° of the 360° circumference) is exposed in the illustrated embodiment.” With this configuration, segments of the base member extend around a top portion of the support member to hold the support member within the groove. Applicants also note that there is no requirement that a claim amendment or new claim must include exactly the same language as provided in the specification. MPEP §608.01. Reconsideration and allowance of the application, as amended, are respectfully requested.

I. Withdrawn Rejections

Applicants acknowledge that the prior rejection of claims 38-43 and 47-49 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,889,694 has been withdrawn. Applicants acknowledge that the prior rejection of claims 1-8, 10, 11, 13-18, 20, 22 and 47-52 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,277,177 to Tetzlaff et al. (“Tetzlaff”) in view of U.S. Patent No. 6,162,220 to Nezhat (“Nezhat”) has also been withdrawn.

Applicants also acknowledge that the rejection of claim 45 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,889,694 to Hooven (“Hooven”) has also been withdrawn.

II. Claims 1-8, 13-18, 22, 38-43, 45, 47-49 and 52 Are Patentable Over Francischelli in view of Tetzlaff and Hooven

Independent claims 1, 14, 38 and 47 and respective dependent claims 2-8, 13, 15-18, 22, 39-43, 45, 48, 49 and 52 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,807,968 to Francischelli *et al.* (“Francischelli” in view of previously cited and previously addressed Tetzlaff and Hooven. Applicants respectfully traverse the rejection.

It is conceded that “Francischelli *et al.* also fail to disclose a stimulation element or means for transmitting stimulation energy carried by the support member and a source of stimulation energy.” Office Action (p. 3). Further, it is conceded that “Francischelli *et al.* fail to disclose the mating structure is configured for removably securing the base member to the first clamp member.” Office Action (p. 3). Not only is this correct, but Francischelli does not disclose a base member that has a mating structure, and does not disclose a base member that defines a groove configured to receive a support member.

More particularly, Francischelli fails to disclose, teach or suggest “a base member including a mating structure and defining a groove therein, the mating structure being configured for removably securing the base member to the first clamp member” as recited in claims 1, 14, 38 and 47. It is alleged that the coating or paint 27 described by Francischelli is a “base member” as recited in claim 1. Office Action (p. 2). It is further alleged that the electrode 24 is a “support member” as recited in claims 1, 14, 38 and 47, and that the coil 32B is a “coagulation element”. Office Action (p. 3). Whatever component is alleged to be a “base member,” as recited in the claims, a “base member” includes: 1. a mating structure, and 2. a groove. Moreover, as recited in the claims, a groove is defined “within the base member.” Further, as recited in the claims, the mating structure is removably securable to the first clamp member.

Francischelli, however, explains that jaws 18 and 19 are made of a metallic core 26, 28 that is coated by paint, 27, 29. Francischelli (col. 3, line 66 – col. 4, line 1) (emphasis added). As is well understood, a coating of paint 27 does not include a mating structure, and certainly does not include a mating structure that configured for removably securing the base member to a clamp member. Further, paint 27 does not define a groove configured to receive a support member. Rather, as is well understood, paint 27 is simply a thin coating. The Office Action has not explained how a portion of the paint 27 is removed or scratched to define a groove “therein” and “within” the paint 27 that receives a support member.

Thus, paint 27 is not related to a base member that includes both a groove and a mating

structure as recited in the claims. It is respectfully submitted that the Office Action relies on a component of Francischelli that is irrelevant to the claims, and that would not even be considered by a person of ordinary skill in the art who understands that paint 27 is not, does not have, and is not related to, a base member including a mating structure and defining a groove and being configured for removably securing the base member to a clamp member. As would naturally be expected, paint 27 applied to the core 26 is intended to be a coating, not for removably securing something to a clamp. Thus, it is respectfully submitted that the Office Action allegations are misplaced and fatally flawed. While Applicants appreciate that the Examiner has interpreted the claim language broadly, the prior art cannot be contorted into something it is not in order to support a rejection.

It is further alleged that the component 24 described by Francischelli is a “support member” as recited in claims 1, 14, 38 and 47. This allegation, however, fails to consider the fact that Francischelli actually explains that this component is an electrode 24 that includes a tube 32A and a coil 33A (as indicated by arrows in Fig. 2B). Thus, the electrode 24 is not a support member that carries coagulation and stimulation elements, such as coagulation and stimulation electrodes. In other words, the Office Action alleges that components “24” and “32B” are different components and that component 24 carries 32B, when in fact, 32B is part of 24, *i.e.*, the coil 32B is part of the electrode 24. Thus, the electrode 24 is not, and cannot be, a “support member” that carries an electrode in the form of a coil 32B since, as actually explained by Francischelli, the coil 32B and electrode 24 are not different and separate components. The Office Action, therefore, follows the inconsistent line of reasoning that “coil 32B is carried by an electrode 24 that includes itself” and is inconsistent with what is actually described by Francischelli and the language of claims 1, 14, 38 and 47.

Thus, although Applicants believe the above remarks eliminate Francischelli from further consideration, Applicants also address the other cited references and explain why the alleged combination of other references with Francischelli and associated modifications are not supported by what is actually described by the references.

Tetzlaff is cited for the limited purpose of mating structure, and Hooven is cited for the limited purpose of allegedly disclosing a stimulation element. (Office Action, p. 3). Tetzlaff and Hooven, however, do not cure the deficiencies of Francischelli discussed above. Thus, even if the alleged combination of three references can somehow be made, the combination would nevertheless fail to disclose, teach or suggest each limitation of each rejected claims.

It is also generally alleged, without considering or addressing the associated modifications to the cited references, that it would have been obvious to “modify the invention of Francischelli et al., as taught by Tetzlaff et al., to provide an insulative base member with a mating structure that is removably securable to the clamp member.” Office Action (p. 3). However, the Office Action allegation, as best as can be understood, involves modifying the coating or paint 27 (the alleged “base member”) to have a mating structure and to carry a stimulation element. Paint 27 is, quite simply, paint. As is well understood, paint 27 is not something that is readily reconfigurable since it is thin coating. Understandably, the Office Action does not explain how this could be done, assuming it is even possible, since paint is obviously not suitable for such modifications, and a person of ordinary skill in the art certainly would not consider, much less consider it obvious, to “modify” the paint or coating 27 as alleged in the Office Action to have a mating structure and a stimulation element. Paint 27 coating is presumably so thin that such modifications are not possible or practical, again noting that whatever component is alleged to be a “base member,” as recited in the claims, a “base member” nevertheless includes: 1. a mating structure, which is removably securable to a clamp member, and 2. a groove, which is defined “within the base member” for receiving a support structure that carries both a coagulation element or means and a stimulation element or means.

Moreover, the general allegations fail to consider the particular structural configuration of the electrodes 24, *i.e.*, they include a coil and tube, and conductive fluid or saline flows “along the length of the electrodes 24 and 25.” Francischelli (col. 3, lines 19-20; Figs. 2A-B). Making substantial modifications to Francischelli as alleged, if they are even possible, would presumably result in altering the electrode 24 configuration. The Office Action, however, does not consider and does not address how the fluid chamber remains operable to allow conductive fluid to flow along the length of the electrodes through an inner lumen of an electrode.

Additionally, given the particular structural configuration of the paint 27 (the alleged “base member”), Francischelli also teaches away from “a support member, the groove formed within the base member being configured to receive the support member” since the coating of paint 27 is not amenable to this structural configuration unless, *e.g.*, the paint is scratched to define some type of groove, but this is not practice, and any scratch would be so small such that any groove that is formed would not be of sufficient size to receive a base member as recited in the claims. For similar reasons, Francischelli teaches away from the substantial configurations alleged in the Office Action since it would be very difficult, if not impossible, to reconfigure a

coating of paint 27 as alleged in the Office Action.

Francischelli also explains that the jaws 18 and 19 “are made of a metallic core 26, 28” (Francischelli (col. 3, lines 66-67)), but the Office Action does not explain how molded plastic snap-fit components as described by Tetzlaff would be integrated into or used with metallic core components 26, 28 and paint 27 coatings.

Accordingly, the cited references, individually and even if somehow properly combined fail to disclose, teach or suggest each limitation of each of claims 1, 14, 38 and 47. Further, a person of ordinary skill in the art would not combine the three references given their very different structural configurations, materials, and the substantial restructuring and modifications that would be required, if they are even possible. Further, various references teach away from Applicants’ claims. Applicants, therefore, respectfully submit that independent claims 1, 14, 38 and 47 are patentable over the three cited references. Dependent claims 2-8, 13, 15-18, 22, 39-43, 45, 48, 49 and 52 incorporate the elements of respective independent claims 1, 14, 38 and 47 and, therefore, are also believed patentable over the cited references.

Applicants respectfully request that the rejection of claims 1-8, 13-18, 2, 38-43, 45, 47-49 and 52 under §103(a) be withdrawn.

III. Claims 10, 20 and 50 are Patentable Over Francischelli in view of Tetzlaff and Hooven and What is Known in the Art

Dependent claims 10, 20 and 50 incorporate the elements and limitations of respective independent claims 1, 14 and 47 and, therefore, are also believed patentable over the three cited references and what is known in the art. What is known in the art does not cure the deficiencies of the three cited references and, therefore, the references, individually and in combination, cannot support the rejection.

IV. Claims 11 and 51 are Patentable Over Francischelli in view of Tetzlaff and Hooven and What is Known in the Art

Dependent claims 11 and 51 incorporate the elements and limitations of respective independent claims 1 and 47 and, therefore, are also believed patentable over the cited references and what is known in the art. What is known in the art does not cure the deficiencies of the three cited references and, therefore, the references, individually and in combination, cannot support the rejection.

V. New Claims 53-59 are Patentable Over the Cited References

Dependent claims 53-59 incorporate the elements and limitations of independent claim 1

and, therefore, are also believed patentable over the cited references, individually and in combination, cannot support the rejection.

For example, claim 53 recites *inter alia* “wherein the base member is formed from a polymer.” It is alleged that the “base member” as recited in claims 1 and 53 is paint 27. Office Action (p. 3); Francischelli (col. 4, line 1). Francischelli does not explain that the paint 27 is formed of a polymer, consistent with the understanding of a person of ordinary skill in the art. Similarly, Francischelli fails to disclose, teach or suggest “wherein the base member is formed from polyurethane” as recited in claim 54.

Further, Francischelli fails to disclose, teach or suggest “an adhesive that holds the coagulation element and the support member in place” as recited in claim 55. It is alleged that the “support member” is an electrode 24 and the electrode is a coil 32B. Office Action (pp. 2-3). The deficiencies of this allegation are discussed above, i.e., the electrode 24 and coil 32B are not different components. Rather, the coil 32B is part of the electrode 24. Francischelli (Fig. 2B). Moreover, Francischelli provides no such description.

Francischelli also fails to disclose, teach or suggest “wherein the mating structure is configured for slidably securing the base member to the first clamp member” as recited in claim 56. Further, based on the description provided and the Office Action allegation that relies on paint 27, such a structural configuration is not required. Moreover, Tetzlaff describes a different configuration in which components are snap-fit together. Tetzlaff (Figs. 5-7; col. 7, line 3) (“snap-fit engagement”).

Francischelli also fails to disclose, teach or suggest “wherein the coagulation element is carried on the support member, the support member being positioned within the coagulation element” as recited in claim 57. Again, as discussed above, the deficiencies of the Office Action allegations regarding an electrode 24 (alleged “support member”) and coil 32B (alleged “coagulation element”) are discussed above and not repeated.

Additionally, Francischelli fails to disclose, teach or suggest “wherein the base member is formed from a non-metallic material” as recited in claim 58. The deficiencies with respect to paint 27 being a “base member” that includes both a mating structure and a groove are discussed in detail above. Applicants further note that the cores 26, 27 are metallic. Francischelli (col. 3, line 67).

Francischelli also fails to disclose, teach or suggest “wherein segments of the base member extend around a top portion of the support member to hold the support member within

the groove” as recited in claim 59.

CONCLUSION

In view of the foregoing claim amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: May 19, 2008

By: / Gary D. Lueck /

Gary D. Lueck
Reg. No. 50,791
Attorneys for Applicants

2040 Main Street, 9th Floor
Irvine, CA 92614
Telephone: (714) 449-8433
Facsimile: (949) 625-8955